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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-------------------------|------------------------|
| 10/017,135 | 12/07/2001 | Neil Russell Foster | HILLS1100 | 8942 |
| 28213 | 7590 | 07/25/2007 | | |
| DLA PIPER US LLP 4365 EXECUTIVE DRIVE SUITE 1100 SAN DIEGO, CA 92121-2133 | | | EXAMINER OH, SIMON J | |
| | | | ART UNIT 1618 | PAPER NUMBER |
| | | | MAIL DATE 07/25/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/017,135 | Applicant(s) FOSTER ET AL. | |
| | Examiner Simon J. Oh | Art Unit 1618 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Papers Received

Receipt is acknowledged of the applicant's amendment, response, and petition for extension of time, all received on 01 May 2007.

Claim Rejections - 35 USC § 112

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The rejection of Claim 1 under 35 U.S.C. 112, second paragraph, as being indefinite is hereby withdrawn in view of the present amendment to the claim

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The rejection of Claims 21-24 and 27 under 35 U.S.C. 102(b) as being anticipated by Debendetti *et al.* is rendered moot with the cancellation of those claims.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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The rejection of Claims 21-24 and 27-29 under 35 U.S.C. 103(a) over Debendetti *et al.* (U.S. Patent No. 6,063,910) in view of Merrified *et al.* (PCT Publication No. WO 00/37169) is rendered moot with the cancellation of those claims.

The rejection of Claims 1-20 under 35 U.S.C. 103(a) over Debendetti *et al.* (U.S. Patent No. 6,063,910) in view of Merrified *et al.* (PCT Publication No. WO 00/37169) is maintained.

Response to Arguments

Applicant's arguments filed 01 May 2007 have been fully considered but they are moot in view of the new grounds of rejection, set forth above.

The applicant argues that the prior art does not teach each and every limitation of the instant claims, where the prior art allegedly does not disclose the use of an aqueous solvent. However, the prior art clearly establishes the use of such aqueous solvents. Within Debendetti *et al.*, water/ethanol solutions are clearly known and described, including the use of aqueous ethanol (See Debendetti *et al.*, Column 6, Lines 23-32; and Claim 5). Merrified *et al.* is also very clear on this disclosure, where water is disclosed as a solvent, which may also be present in mixture with other solvents, such as C₁₋₅ alcohols (See Merrified *et al.*, Page 6, Lines 18-23). It is the position of the examiner that the prior art is not only limited to what is disclosed in the examples and that it should be fairly considered for all that it contains, including non-preferred and non-exemplary embodiments. As such, the disclosure of the use of an aqueous solvent is fairly disclosed by the prior art. See MPEP § 2123 and 2141.02.

Furthermore, the applicant has not qualified what is precisely meant by the term "aqueous solvent", with regard to how much water must be present in order to fall within the applicant's

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definition of an "aqueous solvent", as such a term has not been precisely defined in the instant specification.

The applicant also argues that there is no reasonable expectation of success in combining the references, stating that particle precipitation processes involving dense gases are very sensitive to even minor changes to such processes. However, the examiner takes the position that absolute predictability is not required to establish obviousness. Only a reasonable expectation of success is needed, and that given the high level of skill required for one of ordinary skill in the art to practice such processes, one of ordinary skill in the art would have sufficient knowledge to have a reasonable amount of predictability in determining the effects in altering the parameters of such precipitation processes. See MPEP § 2143.02.

As the prior art discloses the use of aqueous solvents and provides a sufficient motivation to combine with a reasonable expectation of success, the prior art rejection of record is maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Simon J. Oh whose telephone number is (571) 272-0599. The examiner can normally be reached on M-F 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Simon J. Oh
Examiner
Art Unit 1618

sj0


MICHAEL G. HARTLEY
SUPERVISORY PATENT EXAMINER